

REMARKS

Claims 1 through 64 were pending and rejected in the Office Action mailed January 5, 2004. A restriction requirement was entered against claims 11-18 and 55-64. Applicant elects claims 1-10 and 19-54 for without traverse. Claims 1-7, 9-10, 19-23, 25-33, 35-40, 42-51, and 53-54 were rejected under 35 USC 102(b) as being anticipated by U.S. Patent No. 6,628,928 to Crosby. In addition, claims 8, 24, 34, 41, and 52 were rejected under 35 USC 103(a) as being obvious over Crosby in view of U.S. Patent No. 6,526,335 B1 to Treyz et al. Claims 1, 10, 19, 26, 27, 36, 37, 44, 47, 48, 49, and 54 have been amended for clarity as described below. Based on the following remarks, Applicants respectfully request consideration of pending claims 1-10 and 19-54.

REJECTIONS UNDER § 102(B)

In the September 2, 2004 Office Action, claims 1-7, 9-10, 19-23, 25-33, 35-40, 42-51, and 53-54 were rejected under 35 USC 102(e) in view of Crosby (US Patent 6,628,928)

Under 35 USC 102, every limitation of a claim must identically appear in a single prior art reference for it to anticipate the claim. See *Gechter v. Davidson*, 116 F.3d 1454 (Fed. Cir. 1997). There must be no difference between the claimed invention and the reference disclosure. See *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565 (Fed. Cir. 1991). Anticipation can be found only when the reference discloses exactly what is claimed. See *Titanium Metals Corp. v. Banner*, 778 F.2d 775 (Fed. Cir. 1985).

As previously presented, there are limitations in the present invention that do not appear in Crosby. First, the user interface of the present invention claims in 1, 19, 27, 37, 44, 47, 48, and 49 recording requests of a user; therefore, it is interactive. Interactive content over the user interface at the vehicle is not taught or suggested by Crosby. A display for viewing some of the content appears in Crosby; however, the display is not interactive and does not display all of the content. Crosby instead teaches content that is fully displayed and interactive at home or the

office on a personal computer over the internet: 1) "[T]he system provides information pertaining to the program segment to the subscriber within a web site accessible by a home or office computer of the subscriber or within e-mails transmitted directly to an email account of the subscriber," 2) "In this manner, the subscriber can select various advertisements, musical selections or the like while listening to the radio, then access the Internet at a later time to review information pertaining to the various program segments that have been selected," 3) "One advantage of the Internet feedback system of the invention is that the subscriber need not necessarily make decisions immediately regarding purchase of goods or services while listening to the radio broadcast but may defer decisions until a later time," 4) "Moreover, by providing text and graphic information through the Internet to a home or office computer of the subscriber, the mobile unit need not necessarily include a graphic display and hence may be less expensive and thereby more desirable for some potential subscribers." All the dependent claims are allowable for the same reason. However, the following dependent claims are allowable for the independently sufficient reason that they add a further limitations that are nowhere taught or suggested in Crosby. First, the present invention claims in 4, 20, 30, 38, and 50 the ability to present at least a portion of the content or the message audibly. The audible presentation of information is nowhere taught or suggested by Crosby. Second, the present invention claims in 6, 22, 7, and 23 the ability to capture user requests by recording phonation and performing voice recognition processing of the phonation. Recording phonation and performing voice recognition processing of the phonation is nowhere taught or suggested by Crosby. Third, the present invention claims in 8, 24, 34, 41, and 52 contacting a bank system and executing a monetary transfer. As the recent Office Action recognizes on Page 7, contacting a bank system and executing a monetary transfer is nowhere taught or suggested by Crosby. Fourth, the present invention claims in 48 a user interface that displays television and content associated with the television broadcast. Television and content based on the television broadcast does not appear in Crosby.

Currently amended, there are limitations in the present invention that do not appear in Crosby. First, claims 1, 19, 27, 37, 44, 47, 48, and 49 have been amended to include the limitation of automatically displaying content associated with the broadcast. This amendment finds support on lines 10-20 on page 4 of the original specification. The automatic display of content allows the user to select from information that is directly related to the current radio broadcast without having to first take affirmative steps to access the information. Crosby does not teach the automatic display of content. Instead, the user in Crosby is required to take affirmative steps to obtain content: "Subscriber selects program segments of interest by pressing an interactive radio control button on the mobile unit." and "Once the program segment has been identified, the system provides information...." See Crosby. All the dependent claims are allowable for the same reason. However, the following dependent claims are allowable for the independently sufficient reason that they add a further limitations that are nowhere taught or suggested in Crosby. First, claims 9, 26, 36, 43, 54 have been amended to clarify the present inventions ability to directly provide e-commerce. This amendment finds support on line 25 page 4 of the original specification. Direct e-commerce enables the invention to exercise more control over the products that are offered and the security of personally identifiable information. Crosby does not teach direct e-commerce. Instead, Crosby only provides information and links to other e-commerce sources: 1) "[L]inks are provided for permitting the CD to be purchased through other e-commerce web sites," 2) "Other e-commerce web sites permit the subscriber to generate and purchase," and 3) "[P]rovides links directly to e-commerce web sites." Second, claims 9, 25, 35, 42, and 53 have been amended to add the limitation of contacting a physical business establishment. This amendment finds support in the original specification on page 7, lines 6-10. Contacting physical business establishments does not appear in Crosby. Instead, the Crosby invention solely interacts with other e-commerce sites.

Case law has established that every limitation must identically appear in a single prior art reference with no difference between the claimed invention. See *Gechter v. Davidson*, 116 F.3d

1454 (Fed. Cir. 1997), See *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565 (Fed. Cir. 1991), See *Titanium Metals Corp. v. Banner*, 778 F.2d 775 (Fed. Cir. 1985). Therefore, Crosby does not anticipate the present invention because there are distinct differences between Crosby and the present invention and Crosby does not disclose exactly what is claimed. Applicant respectfully suggests that the claims are allowable over Crosby.

REJECTIONS UNDER § 103(A)

In the September 2, 2004 Office Action, claims 8, 24, 34, 41, and 52 were rejected under 35 USC 103(a) over Crosby in view of Treyz (US Patent 6,526,335).

Case law establishes that teachings may not be combined to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination *in the references*. See *In re Bond*, 910 F.2d 831 (Fed. Cir. 1990); *Elf Atochem North America, Inc. v. LaRoche Industries, Inc.*, 85 F. Supp.2d 336 (D. Del. 2000); *SmithKline Diagnostics, Inc. v. Helena Laboratories Corp.*, 859 F.2d 878 (Fed. Cir. 1988) (Examiner may not pick and choose among individual elements of assorted prior art references to recreate the claimed invention absent some teaching or suggestion in the references to support the use in the particular claimed combination); *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.* (1986) (a reference should be considered as a whole). *In re Mahurkar Patent Litigation*, 831 F. Supp. 1354 (N.D. Ill. 1993), *aff'd* 71 F.3d 1573 (Fed. Cir. 1995) (unless the prior art *itself* suggests the particular combination, it does not show that the actual invention was obvious). Therefore, references may only be combined when there is a teaching, suggestion, or incentive to do so in the references.

The present invention teaches, among other things, a method of tailoring information provided to the user based upon local radio station broadcasts. This aspect of the invention results in automation and customization. The issue then is whether Treyz teaches or suggests combining its financial transactions with the present invention. Applicant respectfully suggests that Treyz does not expressly or inherently teach or suggest tailoring information provided to the

user based upon local radio station broadcasts – indeed, it does not even provide any reason or incentive for such a combination. Therefore, Treyz may not be properly combined with Crosby to support a rejection under 35 USC 103. As the Federal Circuit has consistently held:

”With hindsight the transistor is obvious; but devising the transistor was still a work of genius. An invention lies in a *combination of elements that are themselves mundane* ... Unless the prior art *itself* suggests the particular combination, it does not show that the actual invention was obvious or anticipated.” *In re Mahurkar Patent Litigation*, 831 F. Supp. 1354 (N.D. Ill. 1993), *aff’d* 71 F.3d 1573 (Fed. Cir. 1995) (emphasis added).

Finally, assuming *arguendo* that the combination was proper, there are many other limitations taught in the present invention that are not taught by the combination of Crosby and Treyz. These limitations are set forth in the Section 102 Rejections above.

CONCLUSION

In view of the above amendments and remarks, Applicants respectfully submit that claims 1-7, 9-10, 19-23, 25-33, 35-40, 42-51, and 53-54 are not anticipated by Crosby. Further, Applicants submit that claims 8, 24, 34, 41, and 52 are not obvious in view of Crosby in further view of Treyz et. al. Applicants accordingly submit that all claims are in condition for allowance.

Respectfully submitted,

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MAIL CERTIFICATE

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2 March 2005

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